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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DAN KIKINIS

Appeal 2008-4873
Application 08/811,648
Technology Center 2400

Decided: April 30, 2009

Before JOSEPH L. DIXON, HOWARD B. BLANKENSHIP, and
ST. JOHN COURTENAY III, *Administrative Patent Judges*.

BLANKENSHIP, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

This is an appeal under 35 U.S.C. § 134(a) from the Examiner's final rejection of claims 1-4, 7-9, and 14-17, which are all the claims remaining in the application. We have jurisdiction under 35 U.S.C. § 6(b).

We reverse the Examiner's rejection, *pro forma*, and enter new grounds of rejection as permitted by 37 C.F.R. § 41.50(b).

Invention

Appellant's invention relates to a method and system for delivering public network signals (such as Asynchronous Transfer Mode (ATM) signals) to a telephone wiring structure at a destination site, such as a home or business. A micro-PBX (Fig. 3, element 301) manages the destination network bus and translates between the ATM protocol and a non-ATM (e.g., local area network (LAN) data protocol. (*See Abstract; Spec. 3: 19-29, 9:12-28.*)

Representative Claim

1. A networking system for a home or business site, comprising:
 - a bridge adapter unit at the home or business site, having a first connection point for connecting to an external communication network and receiving public network protocol signals; and
 - a telephone wiring structure in the site, the wiring structure having multiple end points and one or more junctions, and connected at a single point to a second connection point of the bridge adapter unit;

characterized in that the bridge adapter unit operates the telephone wiring structure according to a Local Area Network (LAN) protocol, translates received public network protocol signals to a LAN protocol required by the telephone wiring structure, and modulates the

signals in a manner to correct any signal variations at the end points due to having multiple end points operated from a single point at the bridge adapter unit.

Prior Art

Chau	U.S. 5,764,750	Jun. 9, 1998
Goodman	U.S. 5,844,596	Dec. 1, 1998
Eames	U.S. 6,317,884 B1	Nov. 13, 2001

Examiner's Rejections

Claims 1-4, 7-9, and 14-17 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Goodman, Chau, and Eames.

I.

Related Appeals

According to Appellant, “[t]here are no related appeals of the claims in this case . . .” (Br. 2.) Appellant is incorrect.

Appellant filed an earlier appeal in this case. The proceeding was remanded to the Examiner for: (1) consideration of a rejection under 35 U.S.C. § 112, first paragraph; and (2) clarification of why a U.S. patent cited against the claims was considered to be a reference under 35 U.S.C. §§ 102 and 103. (*See* Remand to the Examiner in *Ex parte Dan Kikinis*, Appeal No. 2004-2274 (BPAI Jan 28, 2005) (hereinafter “Board Decision of 28 Jan. 2005”)).

Subsequent to the remand, the Examiner entered a rejection against all the pending claims under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. (*See* Non-final rejection mailed 06 Apr. 2005.) Later in prosecution, after presentation of amendments and arguments by Appellant (14 Feb. 2006), the Examiner withdrew the § 112 rejection.

Further, in a related application,¹ the Board affirmed the rejection of claims directed to a home networking system, which used conventional telephone wiring and translated ATM signals to a LAN protocol.² The claims were rejected over the combination of two references (Goodman and Chau) that are applied in this appeal. (*See* Decision on Appeal in the related application, *Ex parte Dan Kikinis*, Appeal No. 2007-2258 (BPAI Sept. 27, 2007)).

II.

The Standing Rejections

We reverse, *pro forma*, the Examiner’s rejection of the claims over the prior art, because the claims are indefinite under 35 U.S.C. § 112, second paragraph. Rejections of claims over prior art should not be based on speculation and assumptions as to the scope of the claims. *See In re Steele*, 305 F.2d 859, 862 (CCPA 1962). We enter new grounds against all the claims on appeal, *infra*.

¹ Application 09/738,054, now abandoned, which indicated a “divisional” status with respect to Application 09/103,499, which the related application indicated to be a “Continuation-in-Part” of the instant application.

² The Appeal Brief in the related application was filed 22 May 2006. The instant Appeal Brief was filed 24 January 2007.

III.

Definiteness

The function of claims is (1) to point out what the invention is in such a way as to distinguish it from the prior art; and (2) to define the scope of protection afforded by the patent. *In re Vamco Machine & Tool, Inc.*, 752 F.2d 1564, 1577 n.5 (Fed. Cir. 1985). The legal standard for definiteness is whether a claim reasonably apprises those of skill in the art of its scope. *In re Warmerdam*, 33 F.3d 1354, 1361 (Fed. Cir. 1994). The inquiry is merely to determine whether the claims do, in fact, set out and circumscribe a particular area with a reasonable degree of precision and particularity. *In re Moore*, 439 F.2d 1232, 1235 (CCPA 1971). The definiteness of the language employed must be analyzed -- not in a vacuum, but in light of the teachings of the prior art and of the particular application disclosure as it would be interpreted by one possessing the ordinary level of skill in the pertinent art. *Id.*

New Grounds of Rejection -- 35 U.S.C. § 112, Second Paragraph

We reject claims 1-4, 7-9, and 14-17 under 35 U.S.C. § 112, second paragraph, as being indefinite. Claims 1 and 7 are independent. We will discuss claim 1 as representative of both the independent claims.

Claim 1 recites that the bridge adapter unit translates received public network protocol signals to a LAN protocol. An example of this “translation” appears at page 9 of the Specification. ATM packets may be converted to TCP/IP protocol.

Claim 1 further recites that the bridge adapter unit “modulates the signals in a manner to correct any signal variations at the end points due to having multiple end points operated from a single point at the bridge adapter unit.” As we find later in this opinion, this functionally defined “modulates” recitation is not described in the disclosure consistent with the written description requirement of 35 U.S.C. § 112, first paragraph.

The claim recites that the unit modulates “the signals” in a recited manner. The only “signals” expressly set forth in claim 1 are the public network protocol (e.g., ATM) signals. The recitation thus suggests that the public network protocol “signals” are modulated. However, the functionally defined modulation refers to the site’s telephone wiring structure. Thus, the “modulates” might be with respect to “signals” that have been translated to some other form than the public network protocol signals.

In any event, the Specification does not provide any indication of what might be meant by “in a manner to correct any signal variations at the end points due to having multiple end points operated from a single point at the bridge adapter unit.” We decline to speculate on the metes and bounds of the recited language, absent some disclosed example or some disclosed indication in the Specification as to what the recitation is to mean.

Although of secondary importance in comparison to the final two lines of claim 1, the claim also contains words that tend to obscure rather than clarify the subject matter that is claimed.

Claim 1 recites that the bridge adapter unit “operates” the telephone wiring structure according to a LAN protocol. Literal support for the “operates” perhaps may be found at page 9, lines 12 through 19 of the

Specification as filed. The Specification states that micro-PBX 301 “operates” the in-house wiring as a bus system under a protocol such as Carrier Sense Multi Access/Collision Detect (CSMA/CD) protocol, which incidentally is different from the later named “LAN” protocol in claim 1 (e.g., TCP/IP). However, the micro-PBX does not “operate” telephone wiring structure according to a LAN protocol (e.g., CSMA/CD). As known in the art, CSMA/CD is a contention protocol for avoiding collisions of data when two or more devices are attempting to use the same data channel at the same time. CSMA/CD is not a protocol for “operating” structure.

Claim 1 also recites that the bridge adapter unit translates received public network protocol signals to a LAN protocol “required by” the telephone wiring structure. However, we know of no protocols, LAN or otherwise, that are “required by” a telephone wiring structure. Perhaps the subject matter to be claimed relates to a LAN protocol that is “consistent with” a telephone wiring structure.

We decline to construe the claims in such a way to change the meaning of words such as “operates” and “required by,” even if we might find acceptable substitute words, because the claims are amendable. The burden is the applicant’s, not the USPTO’s, to precisely define the invention. *In re Morris*, 127 F.3d 1048, 1056 (Fed. Cir. 1997). “An essential purpose of patent examination is to fashion claims that are precise, clear, correct, and unambiguous. Only in this way can uncertainties of claim scope be removed, as much as possible, during the administrative process.” *In re Zletz*, 893 F.2d 319, 322 (Fed. Cir. 1989).

IV.

Written Description

To comply with the “written description” requirement of 35 U.S.C. § 112, first paragraph, an applicant must convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession of the invention. The invention is, for purposes of the “written description” inquiry, whatever is now claimed. *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555, 1563-64 (Fed. Cir. 1991). To “convey with reasonable clarity to those skilled in the art” may also be expressed in terms of whether the “necessary and only reasonable construction” to be given the disclosure by one skilled in the art clearly supports the limitation now claimed. *See Hyatt v. Boone*, 146 F.3d 1348, 1354 (Fed. Cir. 1998) (“We do not view these various expressions as setting divergent standards for compliance with § 112. In all cases, the purpose of the description requirement is ‘to ensure that the inventor had possession, as of the filing date of the application relied on, of the specific subject matter later claimed by him.’”) (quoting *In re Edwards*, 568 F.2d 1349, 1351-52 (CCPA 1978)).

The invention claimed does not have to be described in *ipsis verbis* in order to satisfy the written description requirement. *Union Oil Co. v. Atlantic Richfield Co.*, 208 F.3d 989, 1000 (Fed. Cir. 2000). However, one skilled in the art, reading the disclosure, must be able to immediately discern the limitations now claimed. *See Waldemar Link GmbH & Co. v. Osteonics Corp.*, 32 F.3d 556, 558 (Fed. Cir. 1994) (“The fact finder must determine if one skilled in the art, reading the original specification, would immediately discern the limitation at issue in the parent.”).

We are mindful, however, that the question of written description support should not be confused with the question of what would have been obvious to the artisan. Whether one skilled in the art would find the instantly claimed invention obvious in view of the disclosure is not an issue in the “written description” inquiry. *In re Barker*, 559 F.2d 588, 593 (CCPA 1977). A description which renders obvious the invention for which the benefit of an earlier date is sought is not sufficient. *Lockwood v. American Airlines, Inc.*, 107 F.3d 1565, 1572 (Fed. Cir. 1997).

When a claimed limitation is not present in the written description, it must be shown that a person of ordinary skill would have understood, at the time the application was filed, that the description requires that limitation. See *Hyatt v. Boone*, 146 F.3d at 1353 (“[W]hen an explicit limitation in an interference count is not present in the written description whose benefit is sought it must be shown that a person of ordinary skill would have understood, at the time the patent application was filed, that the description requires that limitation.”).

One shows “possession” by descriptive means such as words, structures, figures, diagrams, and formulas that fully set forth the claimed invention. *Lockwood*, 107 F.3d at 1572. It is not sufficient for purposes of the written description requirement that the disclosure, when combined with the knowledge in the art, would lead one to speculate as to modifications that the inventor might have envisioned, but failed to disclose. *Id.*

New Grounds of Rejection -- 35 U.S.C. § 112, First Paragraph

We reject claims 1-4, 7-9, and 14-17 under 35 U.S.C. § 112, first paragraph, as lacking written description support in the disclosure. Claims 1 and 7 are independent. We will discuss claim 1 as representative of both the independent claims.

The claims have been amended subsequent to the remand, changing or removing some of the language that contributed to the decision to remand the earlier proceeding for consideration of written description issues. However, two recitations remain which caused the earlier proceeding to be remanded to the Examiner.

First, claim 1 recites telephone wiring structure at a home or business site, the wiring structure having multiple end points and one or more junctions, “and connected at a single point” to a connection point of the bridge adapter unit. The earlier Board panel found no description indicating that the telephone wiring structure is connected at a single point. (*See* Board Decision of 28 Jan. 2005 at 2-3.)

According to Appellant, the telephone wiring structure is described at page 7, lines 8 through 14 of the Specification, and in Figure 3, items 302a-d. (*See* Br. 3, “Summary of the Claimed Subject Matter.”)

However, we do not find any basis in the Specification text for the claimed aspect of the invention. Figure 3, if considered alone, might suggest that the telephone wiring is connected “at a single point” to micro-PBX 301. Figure 3, however, is referenced as a “block diagram” (Spec. 4:9-10 and 7:7-8). The lines shown in Figure 3 are present to illustrate the “tree-type architecture” of the telephone wiring. “[L]ines 302b and 302c are shown as

emanating from micro-PBX 301, while lines 302a and 302d proceed from lines 302b and 302c respectively.” (Spec. 9:10-11.)

Appellant’s disclosure thus does not indicate that Figure 3 depicts the actual physical connections between the components. Patent specifications are not production specifications. *See In re Gay*, 309 F.2d 769, 774 (CCPA 1962).

In view of the block diagram of Figure 3 and the text describing what Figure 3 is intended to show, the disclosure does not require that the telephone wiring is “connected at a single point” as now claimed. In other words, that the wiring is “connected at a single point” to the bridge adapter unit is not the “necessary and only reasonable construction” of the Specification’s description of the wiring represented in Figure 3. *See Hyatt v. Boone*, 146 F.3d at 1354.

A second concern of the earlier Board panel, still relevant, is that claim 1 recited the bridge adapter unit “modulates the signals in a manner to correct signal variations at the end points due to having multiple end points driven from a single point at the bridge adapter unit.” The earlier panel found no description indicating that the claimed function was performed by any component in the disclosure. (*See* Board Decision of 28 Jan. 2005 at 3.) Claim 1 was subsequently amended (14 Feb. 2006) to read in its present form that the bridge adapter unit “modulates the signals in a manner to correct *any* signal variations at the end points due to having multiple end points *operated* from a single point at the bridge adapter unit” (differences from earlier claim 1 in italics).

According to Appellant, the presently claimed aspect is described at page 9, lines 8 through 30 of the disclosure. (*See* Br. 3, “Summary of the Claimed Subject Matter.”) We do not find adequate description of the aspect, as now claimed, in the indicated portion of the Specification as filed. We do not find any discussion of “signal variations,” nor of multiple end points operated from a single point of the bridge adapter unit.

We note that Appellant amended the Specification at page 9, during prosecution, consistent with the language that was added to claim 1. (*See* Amendment filed 14 Feb. 2006.) However, Appellant cannot rely on new matter that was introduced into the Specification. *Cf.* 35 U.S.C. § 132 (“No amendment shall introduce new matter into the disclosure of the invention.”).³

DECISION

The Examiner’s rejection of claims 1-4, 7-9, and 14-17 under 35 U.S.C. § 103(a) is reversed, *pro forma*.

In new grounds of rejection, we reject claims 1-4, 7-9, and 14-17, under 35 U.S.C. § 112, second paragraph, as being indefinite, and under 35

³ Appellant also suggests (Amdt. of 14 Feb. 2006 at 7), indeed “reminds the Examiner,” that language added to claims during prosecution -- such as “connected at a single point” -- may be relied upon for written description support, because under “the Four Corners Rule” the claims “may be counted as disclosure.” Absent citation to controlling authority in support of Appellant’s novel “bootstrap” argument, we hold to our view that the written description support required by 35 U.S.C. § 112, first paragraph must be provided by the original disclosure.

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U.S.C. § 112, first paragraph, as lacking written description support in the disclosure.

This decision contains a new ground of rejection pursuant to 37 C.F.R. § 41.50(b) (2007). 37 C.F.R. § 41.50(b) provides “[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review.”

37 C.F.R. § 41.50(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

(1) *Reopen prosecution.* Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner. . . .

(2) *Request rehearing.* Request that the proceeding be reheard under § 41.52 by the Board upon the same record. . . .

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a).

REVERSED -- 37 C.F.R. § 41.50(b)

msc

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